

REMARKS/ARGUMENTS

Request for Telephone Interview

Prior to the next Office Action, the below-signed counsel respectfully requests a telephone interview with the Examiner to discuss the patentability of the independent claims in view of the following brief discussions.

The Office Action

In the above-mentioned Office Action, the Examiner rejected claims 67 and 68 as failing to comply with the written description requirement, maintained the rejection of claims 44-46, 48, 57-58, 61-62, 75 and 77 as being anticipated by La Mers (4,454,180) and claims 47, 49, 50, 52, 54-56, 59-60, 63-64 and 78 as being unpatentable over La Mers; and rejected claims 77-81 and 84-91 as being unpatentable over La Mers. Claims 19-29, 65-66 and 69-74 were allowed. Claims 82 and 83 were objected to, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response to the Office Action, claims 44, 50, 75 and 77 were amended, claims 51, 53, 76, 82, 83, 84 and 89 were cancelled without prejudice or disclaimer and new claims 92-95 were added.

Brief Discussions of Patentability of Independent Claims

The allowance of claims 19-29, 65-66 and 69-74 is acknowledged with appreciation, and they remain in the application.

Claim 77 has been amended to include allowable dependent claim 82.

Allowable dependent claim 83 have been rewritten as new independent claim 92.

Claims 44, 50 and 75 have been amended as suggested by the Examiner to clarify them and are thus now in condition for allowance.

The Examiner in rejecting claims 67, etc. stated that there was no support for "the liner sheet having no cut or weakened lines directly beneath the label." Applicants respectfully traverse these rejections. This feature is shown in the lower left corner of FIG. 3, which shows no cut or weakened lines on the bottom face of the sheet, and in

FIG. 2, and would be understood by one skilled in the art from the written portion of the specification which includes the description of the manufacturing steps. If the Examiner continues to contend that such cut or weakened lines are disclosed either inherently or expressly in the application, he is respectfully requested to point out specifically where in the application they are disclosed.

Claim 57 includes a label first line and a second line parallel thereto and both passing through the label, as shown for example in FIGS. 1, 4, 5 and 6 at 148 and 180. Claim 57 was rejected as being anticipated by La Mers. However, there is no description in this rejection as to where the second line is disclosed in La Mers; and Applicants respectfully contend that the second line is not disclosed therein. Further, it would not have been obvious to add such a second line to La Mers as it would have been contrary to the teachings of La Mers and would render La Mers inoperable as a practical matter.

The Examiner has taken the position that claim language (e.g., “be manually bent”) following the descriptive phrase “adapted to” is “directed to an intended use of the product and is not deemed to be a positive limitation.” In other words, the Examiner has apparently taken the position that the claim language following the descriptive phrase “adapted to” is not a structural limitation. Applicants respectfully submit that the Examiner’s position is incorrect as a matter of law and that language in the body of a claim following the descriptive phrase “adapted to” is in fact a structural limitation. For example, in *In re Venezia*, 189 USPQ 149 (CCPA 1976), some of the claim language at issue was “a pair of elastic sleeves ... adapted to be fitted over the insulating jacket of one of said cables.” *Id.* at 150. Concerning the above-quoted aspect of the claim, the CCPA stated that: “rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is constructed or dimensioned that it can be fitted over the insulating jacket of the cable.” *Id.* at 151-152, emphasis added.

It is also well settled that all limitations must be considered and it is improper to acknowledge specific limitations in a claim that distinguish over the cited references. See, e.g., *In re Boe & Duke*, 184 USPQ 38, 40 (CCPA 1974).

Accordingly, Applicants respectfully submit that the portions of the claims that follow the descriptive phrase "adapted to" are positive structural limitations that must be afforded the same weight as any other limitations recited in the body of a claim. For example, claims 84 and 89 claim a label sheet structure in which the labels and line segments are constructed such that the labels can be peeled off of the liner sheet in a direction perpendicular to the line segments. This is shown, for example, in FIG. 6 of the subject application. In direct contrast, La Mers shows in FIGS. 1, 3 and 17, for example, a construction which provides for peeling in a direction parallel (not perpendicular) to the "line segments."

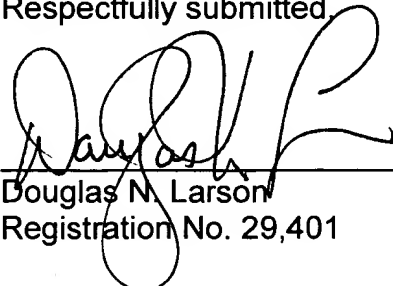
Concluding Remarks

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call Applicants' undersigned counsel at (213) 689-5142 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 07-1853. Should such additional fees be associated with an extension of time, Applicants respectfully request that this paper be considered a petition therefor.

Dated: November 29, 2004

Respectfully submitted,



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